

REMARKS

This communication is in response to the Office Action of February 9, 2007 in which claim 22 is rejected.

Claim 22 is amended to clarify the language as requested by the Examiner. New claims 23 and 24 are added; claims 23 and 24 are fully supported by the specification: claim 23 is supported on page 4, lines 20-21, and claim 24 is supported on page 6, lines 1-4 of the specification. Claim 24 is of similar scope as claims 22 and 23.

Claim 22 is rejected under 35 U.S.C. 112, first paragraph. The Applicant is of opinion that adding composition is not necessary because liquefied gas (aerosol composition) is a disposable substance and it is not a mechanical part or a permanent part of the claimed device. Of course, the aerosol composition is mentioned in the specification and used during the operation of the device which is obvious to a person skilled in the art, but claim 22 is in an "open" form and does not have necessarily to recite all the parts of the device (but only essential parts for describing the novel features of the device), otherwise claim 22 (or any claim for that matter) will be endless. Besides, the preamble of claim 22 states: "An intermittent aerosol dispensing device for application of a product to skin of a human being", which makes it clear to a person skilled in the art that the aerosol composition is used in the device for application to the skin. Furthermore, amended claim 22 further states: "a cylinder adapted to be secured atop an aerosol can, said cylinder communicating with the

product, pressurized in said can, via a port;" which makes it even more clear to a person skilled in the art about aerosol composition used in the device. Besides, new dependent claim 23 further clarifies the issue of the aerosol composition.

As far as terminology in claim 22 such as "a needle", "a hollow piston", etc., to correspond to a written description, as pointed out by the Examiner, the Applicant amended claim 22 to accommodate the Examiner's request, as submitted herein.

Claim 22 was rejected under 35 U.S.C. 102 (b) as being unpatentable over Hiroshi (JP 11-342202; 12/14/99)

The Examiner's arguments regarding 35 U.S.C. 102(b) rejection are analyzed below based on MPEP guidelines which are stated in the MPEP Paragraph 2131 as follows:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP 2131. Further, "the identical invention must be shown in as complete details as is contained in the . . . claim", *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), MPEP 2131.

Regarding independent claim 1, the Examiner's arguments are inaccurate and need further clarification in order to distinguish the present invention from the reference of Hiroshi. Specifically, Hiroshi does not teach or suggest all limitations of claim 22 as required by the MPEP and case law. For example, Hiroshi does not teach that the instant ratio of injection time to stop time is set to

0.1 to 5.0 when a valve is open, as recited in claim 22 of the present invention. Actually, Hiroshi does not talk, mention or even hint about ratio of injection time to stop time,

Thus, the invention recited in claim 22 is not shown in as complete details by Hiroshi as required by MPEP 2131 as quoted above.

Another way of looking at it is that the distinguishing factor in claim 22 is a functionality disclosed in the last paragraph of claim 22 stating that "a ratio of an injection time to a stop time is set to 0.1 to 5.0, when a valve is opened, in order to obtain a sufficient yet not excessive cooling and/or massage effect on the skin." MPEP Section 2173.05(g) states that "A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of the invention in functional terms. Functional language does not, in and of itself, render a claim improper."

In other words, based on the above quote, it is clear that Hiroshi does not disclose the functionality quoted above which makes claim 22 of the present invention novel and not anticipated by Hiroshi, contrary to what is alleged by the Examiner.

The objections and rejections of the Office Action of February 9, 2007 having been obviated by amendment or shown to be inapplicable, withdrawal thereof is requested and passage of all claims to issue is solicited.

Respectfully submitted,



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